

REMARKS

In response to the final Office Action dated June 7, 2005, Applicant respectfully requests favorable reconsideration of the above-captioned application in view of the following remarks and accompanying exhibits. Claims 1-63 remain pending in this application.

Regarding the Propriety of Entry of this Response Under 37 C.F.R. § 1.116

The June 7, 2005 Office Action states that U.S. Published Application No. 2002/0198750 to Innes et al. (referred to as "Innes" below) remains a valid reference because the January 31, 2005 Response did not provide certain details regarding the ERC/GE relationship. Namely, the June 7, 2005 Office Action states, "Applicant's statement indicates ERC was acquired by General Electric Company but does not include the details such as 100% ownership. Applicant is requested to make the assignment of record." This Response addresses the Office Action's request in a manner which is believed to require only a cursory review by the Examiner. For this reason, entry of this Response under 37 C.F.R. § 1.116 (and MPEP § 714.13) is appropriate and is respectfully requested.

Regarding the Office Action's Request for Additional Information

As noted above, the June 7, 2005 Office Action requires Applicant to provide additional information to establish common ownership between the cited Innes document and the present application. With regard to this request, MPEP § 706.02(1)(2) states:

1 The following statement is sufficient evidence to establish common ownership of, or an
2 obligation for assignment to, the same person(s) or organizations(s):

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4 Applications and references (whether patents, patent applications, patent application
5 publications, etc.) will be considered by the examiner to be owned by, or subject to an
6 obligation of assignment to the same person, at the time the invention was made, if the
7 applicant(s) or an attorney or agent of record makes a statement to the effect that the
8 application and the reference were, at the time the invention was made, owned by, or
9 subject to an obligation of assignment to, the same person.

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11 See "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common
12 Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C.
13 103(c)," 1241 O.G. 96 (December 26, 2000). The applicant(s) or the representative(s) of record
14 have the best knowledge of the ownership of their application(s) and reference(s), and their
15 statement of such is sufficient evidence because of their paramount obligation of candor and good
16 faith to the USPTO.

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18 The January 31, 2005 Response included the statement, "The subject matter of the
19 Innes published application and the present claimed invention were, at the time the
20 invention was made, subject to an obligation of assignment to the General Electric
21 Company of Schenectady, New York." Since this statement mirrors both the language of
22 the statute and the MPEP, the prior Response should have been sufficient evidence to
23 remove the Innes document as a valid reference against the present application. Further,
24 the MPEP states that the Examiner's request for additional evidence is reserved for "rare
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1 instances" in which the Examiner has "independent evidence" that raises a material doubt
2 as to the accuracy of Applicant's representations.

3 Nevertheless, in order to advance the prosecution of this application, the
4 Applicant presents additional information regarding the issue of common ownership.

5 First, Applicant expressly makes the statement that the present application (U.S.
6 Serial No. 10/085,497) and the Innes document (U.S. Published Application No.
7 2002/0198750 to Innes et al.) were, at the time the invention of the present application
8 was made, owned by ultimate parent company, General Electric Company (GE) of
9 Schenectady, New York. As noted in MPEP § 706.02(1)(2), this statement *alone* is
10 "sufficient evidence" to disqualify the Innes document from being used in a rejection
11 under 35 U.S.C. § 103(a) against the claims of the present application.

12 In addition, Applicant provides a number of supporting documents, labeled as
13 Exhibits A-D.

14 • Exhibit A shows a timeline of relevant events pertaining to GE's insurance-
15 related business sector. As indicated there, GE purchased ERC in 1984. GE is, and
16 was at the time the invention of the present application was made, the ultimate parent of
17 ERC. More specifically, GE is the "ultimate" parent of ERC in the sense that GE
18 indirectly owns ERC, there being a chain of ownership between GE and ERC;
19 nevertheless, in the chain of ownership from GE to ERC, GE can be said to indirectly
20 (or ultimately) own 100% of ERC, thus satisfying the requirements of 35 U.S.C. §
21 103(c).

22 • Exhibit B is a printout of the Patent Office's online assignment records,
23 indicating that an assignment in the Innes patent application was recorded on October 2,
24 2001. In that assignment, the inventors assigned their patent rights to GE.

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1 • Exhibit C comprises copies of not-yet-recorded assignment documents in the
2 present application, in which all of the inventors except Michael Sutherland have
3 assigned 100% of their patent rights to ERC. While Applicant does not yet have an
4 assignment document executed by Michael Sutherland, Mr. Sutherland was, and
5 presently is, under an obligation to assign his patent rights to ERC.

6 • As evidence of Michael Sutherland's obligations, Exhibit D shows a recorded
7 assignment document in a related patent application, U.S. Serial No. 10/815,099, in
8 which Mr. Sutherland assigned his patent rights to ERC.

9 Based on all of the above, the Applicant submits that the Innes document is not a
10 valid reference against the present application for purposes of a rejection under § 103.
11 Acknowledgement of same is respectfully requested.

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13 *35 U.S.C. § 103 Rejections*

14 Claim 1-4 and 6-60 were rejected under 35 U.S.C. § 103(a) as being unpatentable
15 over Innes in view of U.S. Published Patent Application No. 2002/0087705 to Smyth.
16 Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Innes in view
17 of U.S. Patent No. 6,006,560 to Gill et al. Claims 61-63 were rejected under 35 U.S.C. §
18 103(a) as being unpatentable over Innes in view of U.S. Published Patent Application No.
19 2004/0015422 to Glick et al. Applicant respectfully traverses these rejections for the
20 reasons stated below.

21 As set forth in the previous section of this Response, the subject matter of the
22 Innes published application and the present claimed invention were, at the time the
23 invention was made, subject to an obligation of assignment to the General Electric
24 Company of Schenectady, New York. Accordingly, pursuant to the provisions of 35
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1 U.S.C. § 103(c), the Innes document is not a valid reference against the claimed
2 invention. Since the Innes document is an integral part of the Office Action's three
3 § 103(a) rejections, the Applicant requests that these rejections be withdrawn.

4
5 *Conclusion*

6 The arguments presented above are not exhaustive; Applicant reserves the right to
7 present additional arguments to fortify its position. Further, Applicant reserves the right
8 to challenge the alleged prior art status of one or more documents cited in the Office
9 Action.

10 All objections and rejections raised in the Office Action having been addressed,
11 it is respectfully submitted that the present application is in condition for allowance and
12 such allowance is respectfully solicited. The Examiner is urged to contact the
13 undersigned if any issues remain unresolved by this Response.

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16 Respectfully Submitted,

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18 Dated: 9/7/2005

By: 

David M. Huntley
Reg. No. 40,309
(509) 324-9256